III REMARKS

Summary of Applicant's Invention

Applicant's invention relates to a method of displaying, as a map and a series of graphs on a web page, information about visitors to web pages on the Internet, or viewers of streaming video, for the purpose of monitoring, in real-time, the geographical distribution of visitors viewing advertisements in cyberspace.

A server places ads on a public web page accessible to Internet visitors. The ads are placed in accordance with an ad campaign strategy of an advertiser. Data that includes ad impressions, IP addresses of visitors and geographical data including locations of IP addresses of the visitors are supplied to a servlet. The servlet separates the enhanced data into site-specific data and advertiser-specific data. The site-specific data and a site-specific applet are transferred to a private web page accessible to the site. The site-specific applet dynamically plots indicia representing ad impressions for a site included in the site-specific data on a map on the private web page accessible to the site. The advertiser-specific data and an advertiser-specific applet are transferred to a private web page accessible to the advertiser. The advertiser-specific applet dynamically plots indicia representing ad impressions for the advertiser included in the advertiser-specific data on a map on the private web page accessible to the advertiser. A visual characteristic (color, size, intensity etc.) of an indicium is changed in proportion to a number of the Internet visitors from the same geographical location.

Claim Rejections -35 USC 101

Claims 13-15 were rejected because allegedly directed to non-statutory subject. Examiner states that a "program" in claims 13-15 "is software per se and non-statutory". Applicant respectfully disagrees that software per se is non-statutory. The U.S. Supreme Court has held otherwise:

> "It is said that the decision precludes a patent for any program servicing a computer. We do not so hold. {Gottschalk v. Benson, 409 U.S. at 71, 175 USPQ at 676}

When evaluating the scope of a claim, every limitation in the claim must be considered. It is inappropriate to dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See Diamond v. Diehr, 450 U.S. at 188-89, 209 USPQ at 9 ("In determining the eligibility of respondents' claimed process for patent protection under 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made.").

The courts have held that claims define nonstatutory processes if they:

consist solely of mathematical operations without some claimed practical application (i.e., executing a "mathematical algorithm"); or

simply manipulate abstract ideas, without some claimed practical application.

In Alappat, the Federal Circuit recognized statutory patentable subject matter in claims drawn to a rasterizer for converting discrete waveform data samples into anti-aliased pixel illumination intensity data to be displayed on a display means since the claims defined "a specific machine to produce a useful, concrete, and tangible result." In re Alappat, 33 F.3d 1526, 1544, 31 USPQ2d 1545, 1557 (Fed. Cir. 1994).

Applicant's claim 13 is limited to the use of a particularly claimed combination of elements performing the particularly claimed combination of method steps to receive user-specific data of ad impressions on Internet Web sites and plot indicia of the ad impressions on a map on a private web page. This is a specific method to produce a useful, concrete, and tangible result, i.e. indicia representing ad impressions plotted on a map on a private web page. The map is a "useful, concrete, and tangible result".

Claim Rejections-35 USC 112

Claims 3, 7, 9-12 and 14-15 have been amended to correct Examiner's objections thereto.

Claim Rejections-35 USC 103

Clams 1-20 were rejected under 35 USC 103 as unpatentable over Hitbox 1 and 2 in view of Parekh et al, US PGPUB-2005001853.

Hitbox 1 and 2

Hitbox 1 and 2 discloses an Internet-based analysis tool that follows, in real-time, the flow of traffic through a website. For every website page requested by a website visitor, the state of the visitor's browser is recorded and data relating to the path visitors take through the website is collected and studied. The state of the visitor's browser path is maintained in a traffic analysis cookie that is passed between a website file server and the visitor browser with every page requested for viewing. The data in the cookie can follow the visitor browser through independent file servers, regardless of how the pages of a website might be distributed in storage.

Internet users who maintain websites carefully monitor the pattern of web browser requests for web pages from their website. As with most forms of advertising, a goal of providing a website is to have a large number of visitors to the website to view information on the website. Hitbox 1 and 2 is a software program and monitoring service to track web traffic, and to produce website traffic analysis reports.

Parekh

Parekh discloses an automated computer-implemented method of determining the geographic location of an Internet user. The geographic location of the Internet user is automatically determined by analysis of the route and the geographic locations of intermediate hosts. The geographic location of the Internet user is stored in a database along with the geographic locations of a plurality of other Internet users.

Summary of Arguments for Patentabilty

Hitbox 1 and 2 discloses an Internet-based analysis tool that follows, in real-time, the flow of traffic through a website. Parekh discloses an automated computer-implemented method of determining the geographic location of an Internet user.

In contradistinction, applicant's invention relates to a method of displaying, as a map and a series of graphs on a web page, information about visitors to web pages on the Internet, or viewers of streaming video, for the purpose of monitoring, in real-time, the geographical distribution of visitors viewing advertisements in cyberspace.

The references taken alone or combined do not disclose or suggest separating collected data into per site and per advertiser data sets.

Detailed Argument for Patentabilty

Claim Rejections - 35 USC § 103(a) (Obvious over Hitbox 1 and 2)

Examiner has rejected claims 1-4, 8-9, 13, 16, 19-20 under 35 U.S.C. 103(a) as being obvious over Hitbox 1 and 2 in view of Parekh.

As to the remaining dependent claims, the Examiner is relying not on an additional reference, but on personal knowledge ("official notice") to supply elements of applicant's claims that are not shown or suggested by Hitbox 1 and 2. Applicant respectfully traverses the use of official notice in this instance and requests that the Examiner provide evidence to back up this position in the next Office action or explain why no evidence is required.

Claim 1 is an independent claim and claims 2-7 are dependent thereon.
Claim 8 is an independent claim and claims 9-12 are dependent thereon.
Claim 13 is an independent claim and claims 14-15 are dependent thereon.
Claim 16 is an independent claim and claims 17-20 are dependent thereon.

None of the references disclose or suggest applicant's claimed invention because none disclose or suggest necessary elements of the claimed combination. Applicant's claims call for "an ad server and "an advertising display server". The advertising display server collects the data from the ad server and separates the data into two caches, one containing a per-advertiser data subset (data selected from the advertiser's perspective), the other containing a per-site data subset (data selected from the site's perspective). None of the references disclose or suggest separating data into user-specific data; and using the user-specific data with a user-viewpoint applet in order to plot indicia representing ad impressions on a map on a private web page.

Hitbox 1 and 2 does not have the concept of an information provider and an advertising display server having stored in two caches, data subsets separated from data collected from said ad server and said information provider, a first of said caches having stored therein a per-advertiser data subset, a second of said caches having stored therein a per-site data subset. This structure is what enables the display indicia on a map on a web page, the indicia being located on the map according to geographical locations of Internet visitors.

The distinguishing language in the claims is as follows:

Claim 1 and dependent claims 2-7.

> Said advertising display server having stored in two caches, data subsets separated from data collected from said ad server and said information provider, a first of said caches having stored therein a per-advertiser data subset, a second of said caches having stored therein a per-site data subset.

Claim 8 and dependent claims 9-12:

> B. Separating said collected data into two subsets, a per-advertiser data subset, and a per-site data subset;
>
> ***

D. Selectively feeding said per-site data subset to said site-viewpoint applet and said per-advertiser data subset to said advertiser-viewpoint applet.

Claim 13 and dependent claims 14-15:

A. Receiving user-specific data related to visitors of Internet web sites upon which ads have been placed on a public web page

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B. Plotting indicia representing ad impressions for a site included in said user-specific data on a map on a private web page.

Claim 16 and dependent claims 17-20:

B. Separating said enhanced data into user-specific data; and,
C. Transferring said user-specific data and a user-viewpoint applet to a private web page accessible to said user;
Said user-viewpoint applet capable of plotting indicia representing ad impressions for a site included in said user-specific data on a map on said private web page.

The Examiner has failed to set forth a *prima facie* case of obviousness for rejections combining references under 35 USC 103(a) (obviousness).

The Examiner has failed to set forth a *prima facie* case of obviousness. The MPEP at 706.02 (j) sets forth a process by which a rejection under 35 USC 103 is to be sustained wherein, as in the present case, a single reference (Hitbox 1 and 2) is modified by combining it with one or more references (Official Notice and Parekh)

The MPEP states that to establish a *prima facie* case of obviousness three basic criteria must be met:

Criterion 1 There must be some suggestion or motivation to modify the reference or to combine reference teachings.

Criterion 2 There must be some reasonable expectation of success.

Criterion 3 The references when combined must teach or suggest all the claim limitations.

These three criteria are analyzed below in order to show why the references cannot be properly combined:

Criterion 1

There must be some suggestion or motivation to modify the reference or to combine reference teachings.

There is no suggestion in the references cited to modify the reference or to combine reference teachings. The Examiner states that:

> Hitbox 1 and 2 does not explicitly disclose breaking down the data into per site or per advertiser data sets.

Applicant's invention is a method and apparatus of displaying, as a map and a series of graphs on a web page, information about visitors to web pages on the Internet, for the purpose of allowing advertisers to monitor in real-time, the geographical distribution of visitors viewing advertisements on the Internet.

The claims were rejected as being unpatentable over Hitbox 1 and 2 and Parekh. Hitbox 1 and is the primary reference relied upon, and is the "reference" referred to in criterion 1. Hitbox 1 and 2 is the reference to be modified.

The Examiner proposes that it would be obvious to modify the applied reference (Hitbox 1 and 2) to use the elements of Parekh to provide the missing element, as stated by the Examiner.

> It would have been obvious to one skilled in the art at the time the invention was made to break down the gathered data into per site or per advertiser data sets.

The Examiner has failed to point out why the modification that he proposes would be obvious.

Applicant's invention is a combination and the crucial suggestion or motivation criterion in determining obviousness must be considered. The Examiner has failed to do this. Neither Hitbox 1 and 2 nor Parekh contain anything to suggest the desirability of applicant's claimed combination or any motivation to modify the method of Hitbox 1 and 2 to effectuate a method of displaying, on a web page, information about visitors to web pages on the Internet, for the purpose of monitoring, in real-time, the geographical distribution of visitors viewing advertisements in cyberspace. In order to satisfy this requirement, the Examiner must show that at least one of the references suggests that it is possible or desirable to modify the applied reference to effectuate a method of displaying, on a web page, information about visitors to web pages on the Internet, for the purpose of monitoring, in real-time, the geographical distribution of visitors viewing advertisements in cyberspace.

Criterion 2

There must be some reasonable expectation of success.

There is no reasonable expectation of success in combining the references in the manner that the Examiner suggests. Hitbox 1 and 2 discloses a structure for using cookies of visitors to a website which cookie is passed back and forth between browser and server to track website traffic.

Parekh does not use cookies:

> The use of cookies, for instance, is objectionable to many visitors. In fact, bills have been introduced into the House of Representatives and also in the Senate controlling the use of cookies or digital ID tags. By placing cookies on a user's computer, companies can track visitors across numerous web sites, thereby suggesting interests of the visitors. While many companies may find cookies and other profiling techniques beneficial, profiling techniques have not won wide-spread approval from the public at large.

The two technologies are therefore incompatible there is no reasonable expectation of success in combining the references in the manner that the Examiner suggests.

Criterion 3

The references when combined must teach or suggest all the claim limitations.

As to the dependent claims, Examiner admits that the combination of Hitbox 1 and 2 and Parekh lacks explicit recitation of some elements of the dependent claims, arguing that the combination of Hitbox 1 and 2 and Parekh implicitly shows the same. This third criterion is not met because the references when combined do not teach or suggest all the claim limitations. The teaching or suggestion must be explicit. The limitations that are not shown are:

Claims 1-7: the ad server and display server limitations.
Claims 8-12 the data separating into two data subsets limitations.
Claims 13-15 the data separating and plotting limitations.
Claims 16-20 the data separating and plotting limitations.

In view of the above arguments for patentability, reexamination of claims 1-20 pending in this application and allowance thereof is respectfully requested.

Respectfully submitted,

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PO Box 386
Prescott, AZ 86302-0386

Owen L. Lamb, Reg. #20,831
Attorney for applicant
Phone/fax: (928) 776-8037

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Owen L. Lamb

Owen L. Lamb, Reg. # 20,831